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10/805,738	03/22/2004	Alan K. Schaer	ATR-15CON	9575

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EXAMINER
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VAN, QUANG T

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3742

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/805,738  
Filing Date: March 22, 2004  
Appellant(s): SCHAER ET AL.

**MAILED**  
**SEP 27 2007**  
**GROUP 3700**

William A. Schoneman  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 8/17/2007 appealing from the Office action  
mailed 06/02/2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

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6,097,976	YANG ET AL	8-2000
6,254,599	LESH ETAL	7-2001
6,237,605	VASKA ET AL	5-2001

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-7 and 10-15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Yang et al (US 6,332,880) in view of Yang et al (US 6,097,976). Yang'880 discloses, figure 11, a catheter assembly a transeptal sheath (74); a guiding introducer (26) slidable within the transeptal sheath (74); a deflectable catheter (12) having proximal (14) and distal end (16) portions, wherein the deflectable catheter (12) is configured to be torquable and steerable (col. 11, lines 25-45); and a pullwire (32) integrated within the deflectable catheter (12) that is adapted to deflect at least a portion of the distal end (16) portion such that the deflectable catheter (12) may be advanced through the guiding introducer (26) wherein the guiding introducer (26) directs the catheter (12) towards the pulmonary vein and the catheter (12) is further directed into the pulmonary vein by manipulation of the proximal end portion (14). Yang'880 does not disclose the guiding introducer is pre-shaped to direct the catheter. Yang'976 discloses a guiding introducer is pre-shaped to direct the catheter (col. 2, lines 62-67). It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize in Yang'880 a guiding introducer is pre-shaped to direct

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the catheter as taught by Yang'976 in order to direct the catheter towards the pulmonary vein.

Claim 8 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Yang et al (US 6,332,880) in view of Yang et al (US 6,097,976) and further in view of Lesh (US 5,971,983). Yang'880/Yang'976 disclose substantially all features of the claimed invention except the ablation element comprise a microwave ablation element. Lesh discloses an ablation element comprise a microwave ablation element (col. 9, lines 43-60). It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize in Yang'880/Yang'976 an ablation element comprise a microwave ablation element as taught by Lesh in order to provide the efficient energy to treat the injure or ablate tissue.

Claim 9 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Yang et al (US 6,332,880) in view of Yang et al (US 6,097,976) and further in view of Vaska et al (US 6,237,605). Yang'880/Yang'976 disclose substantially all features of the claimed invention except the ablation element comprising a cryogenic ablation element. Vaska discloses an ablation element comprising a cryogenic ablation element (col. 3, lines 44-51). It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize in Yang'880/Yang'976 an ablation element comprising a cryogenic ablation element as taught by Vaska in order to form a continuous, uninterrupted lesion around or on the pulmonary veins.

**(10) Response to Argument**

In response to argument of

Claims 1-7 and 13-15

Applicants argue that claims 1-7 and 13-15 would not have been obvious to one skill in the art at the time of invention. The examiner disagrees. Yang'880 discloses substantially all features of the claimed invention (as above rejection), including figure 11 show that the guide introducer (26) is pre-shaped to direct the catheter, but Yang'880 does not mention (describe in words) in the specification that the guide introducer (26) is pre-shaped. Therefore, the examiner has to use Yang'976, which also the same Inventor with Yang'880, to combine with Yang'880 to show that the guide introducer is pre-shaped to direct the catheter. Yang'880 and Yang'976, are both invention related to the medical field, are both related to catheter structure assembly, therefore, they are considered related art and one ordinary skill in the art would look into these references to combine.

Applicants also argue that there is no teaching or suggestion in the Yang'976 reference that the "pre-shaped guide sheath" is slidable within a transeptal sheath. This is not found persuasive. Yang'976 used here only to show that the guide introducer is pre-shaped to direct the catheter (col. 2, lines 62-67), and the guide sheath is slidable within a transeptal sheath is already disclosed by Yang'880.

Claim 10

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Applicants argue that "The Examiner did not cite any passage in either Yang reference that discusses thermal ablation". This is not found persuasive. Yang'880 reference teaches the use of RF ablation, which has electrode element (28) to receive electrical energy supply by a source of RF ablation energy to produce at least some heat to heat and ablate heart tissue (col. 7, lines 41-58). Therefore, Yang'880 is inherently disclosed thermal ablation.

#### Claims 11-12

Applicants argue that the examiner did not cite any passage in either Yang reference that discusses light emitting ablation, or ultrasound ablation. This is not found persuasive. Yang'880 disclosed optical fibers for laser, or a fluorescence spectroscopy device (col. 24, lines 50-56), which, thus, meets the limitation of the light emitting ablation and ultrasound ablation (col. 24, lines 51-52).

#### Rejection of Claim 8

Applicants argue that the combination of three references, Yang'880, Yang'976, and Lesh would not have been obvious to one skill in the art. Lesh does not overcome the deficiencies of the primary and secondary references. Lesh does discuss the use of an antenna that would be energized by microwave energy but does not teach or suggest the positioning system of claim 1. Furthermore, there is no teaching or suggestion in any of the references that would lead one skilled in the art to combine all three references into the invention of claim 8. This is not found persuasive. The

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examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Yang'880/Yang'976 disclose substantially all features of the claimed invention except the ablation element comprise a microwave ablation element. Lesh discloses an ablation element comprise a microwave ablation element (col. 9, lines 43-60). It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize in Yang'880/Yang'976 an ablation element comprise a microwave ablation element as taught by Lesh in order to provide the efficient energy to treat the injure or ablate tissue. Further, Lesh's reference is cited for only the teaching of the microwave ablation element, and the other limitations, such as, for example the positioning system, are already covered by Yang'880 and Yang'976.

#### Rejection of Claim 9

Applicants argue that the combination of three references, Yang'880, Yang'976, and Vaska would not have been obvious to one skill in the art. Vaska does not overcome the deficiencies of the primary and secondary references. Vaska does briefly discuss the use of a cryogenic ablation element but does not teach or suggest the positioning system of claim 1. Furthermore, there is no teaching or suggestion in any of the



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references that would lead one skilled in the art to combine all three references into the invention of claim 9. In this case, Yang'880/Yang'976 disclose substantially all features of the claimed invention except the ablation element comprising a cryogenic ablation element. Vaska discloses an ablation element comprising a cryogenic ablation element (col. 3, lines 44-51). It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize in Yang'880/Yang'976 an ablation element comprising a cryogenic ablation element as taught by Vaska in order to form a continuous, uninterrupted lesion around or on the pulmonary veins. Further, Vaska reference is cited for only the teaching of the cryogenic ablation element, and the other limitations, such as, for example the positioning system, are already covered by Yang'880 and Yang'976.

Further, the examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA 1969).

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**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Quang T. Van

Conferees:



Tu Hoang, Supervisory Patent Examiner



Marc Jimenez, Supervisory Patent Examiner